

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Mark PETERS	:	Confirmation Number: 6950
	:	
Application No.: 10/758,853	:	Group Art Unit: 3692
	:	
Filed: January 16, 2004	:	Examiner: B. Fields
	:	
For: SERVER WALLET PROVIDER PORTAL	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated October 28, 2008.

The Examiner's response to Appellant's arguments submitted in the Second Appeal Brief of September 17, 2008 (hereinafter the Second Appeal Brief), raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellant relies upon the arguments presented in the Second Appeal Brief, and the arguments set forth below.

REMARKS

Appellant has compared the statement of the rejection found on pages 3-12 of the Examiner's Answer with the statement of the rejection found on pages 2-12 of the Third Office Action. Upon making this comparison, Appellant has been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellant proceeds on the basis that the Examiner's sole response to Appellant's Second Appeal Brief is found on pages 13-21 of the Examiner's Answer.

Non-Compliant Examiner's Answer

On page 5 of the Second Appeal Brief, Appellant pointed out where the Examiner's Answer is required to include particular content discussed in M.P.E.P. § 1207.02, yet the Examiner has essentially ignored this requirement. Although the Examiner provides a mapping between claim 1 and the applied prior art on pages 15 and 16 of the Examiner's Answer, this mapping fails to "compare [claim 1] feature by feature with the prior art relied on in the rejection" (emphasis added), as required in M.P.E.P. § 1207.02. Instead, the Examiner's analysis refers to whole blocks of limitations without identifying, "feature by feature," the alleged teachings within the applied prior art being relied upon to teachings these features.

As noted throughout the prosecution of this application and in the Appeal Brief, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellant's position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellant and the

Honorable Board gain a better understanding of the alleged findings of facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellant respectfully recommends that the Honorable Board remand the present application to the Examiner to address these omissions.¹

Rejection of claim 1 under 35 U.S.C. § 103

The Examiner's first substantive comments are found on the second full paragraph on page 15 of the Examiner's Answer in which the Examiner asserted the following:

As best understood, the Examiner has included a chart below which better discloses the portions of the references which have been relied upon within the rejection on appeal in efforts to further **"provide a claim construction for the claim language at issue"**. (emphasis in original)

As evident from the Examiner's "chart," the Examiner, apparently, does not understand what is required to provide a claim construction for the claim language at issue. Construing the language of the claims does not involve, e.g., asserting that "a mobile server wallet provider (MSWP) comprising: a configuration for communicative coupling both to a plurality of MSWP's and also a content proxy" is taught by "Abstract; Figs. 3-4,6-7; Pg 2, Para. 30" of Suzuki. Nothing in the Examiner's chart on pages 15 and 16 of the Examiner's Answer constitutes a "claim construction" for any of the claim limitations. Therefore, Appellant respectfully submit that the Examiner's inability to provide this most basic of analysis evidences a fundamental failure, by the Examiner, to properly analyze the claims with respect to the prior art.

¹ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. E.g., Ex parte Daleiden, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); Ex parte Rozzi, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); Ex parte Gambogi, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); Ex parte Schricker, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); Ex parte Braeken, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

Turning to the Examiner's analysis provided in the chart, in essence, the Examiner is relying upon Suzuki for all of the claimed limitations with the exception of "portal." Thus, the Examiner is asserting that Suzuki teaches a mobile server wallet provider (i.e., MSWP) but not the claimed MSWP portal. To be clear, claim 1 recites both a MSWP and a (plurality of) MSWP portal(s), and these are two different types of entities.

Referring to pages 16-18 of the Examiner's Answer, much of what is contained therein are a reproduction of Appellant's arguments. The Examiner's sole response to the arguments presented on pages 7-11 of the Second Appeal Brief (which includes arguments presented in response to the Examiner's First and Second Office Actions, which the Examiner has yet to fully address despite these arguments still being relevant) is found in the last full paragraph on page 18 of the Examiner's Answer and is reproduced below:

The Examiner notes that the Schuba reference has been relied upon to disclose a MSW "portal" not a "wallet portal" as mentioned by Appellants supra. It should be noted that the Schuba reference specifically teaches a MSW "portal" whereas the Suzuki reference shows a "wallet portal" or "portal", as it were, in relation to the discussion cited from the Examiner supra. Thus, one having ordinary skill in the art would recognize that such benefits would not already be obtained by the practice of Suzuki alone.

Despite presenting 5 pages of arguments in the Second Appeal Brief, the Examiner's sole response to these arguments is only directed to Appellant's comments on page 9, lines 11-19, which identified an inconsistency in the Examiner's analysis (see, e.g., page 3, line 12 of the Third Office Action and page 4, line 1 of the Examiner's Answer), in which the Examiner asserted that "Suzuki, however, does not expressly discuss a wallet 'portal'." The remaining arguments presented by Appellant on pages 7-11 of the Second Appeal Brief, however, have gone unchallenged by the Examiner in the Examiner's Answer.

Rejection of claim 3 under 35 U.S.C. § 103

On pages 12-14 of the Second Appeal Brief, Appellant presented several arguments as to the Examiner's rejection of claims 3 and 6. The Examiner's sole response to these arguments is found on page 21 of the Examiner's Answer in which the Examiner asserted the following:

The Examiner notes that Suzuki discloses a relay server, relaying method and payment system. Support for any discussion of a filter within the Third Office Action can be found at least in the Schuba reference at Paragraphs 0002, 0027-0031, and in Claim 7. Furthermore, the legal conclusion that all of the limitations recited in claims 3 and 6 would have been obvious to one having ordinary skill in the art because such a system and method could not operate without some form/type of constraints, or 'rules' as it were.

The Examiner's only new analysis (or response to Appellant's arguments) appears to be the identification of paragraphs [0002] and [0027]-[0031] of Schuba. To be clear, the limitations at issue recite "wherein said WSP further comprises a filter plug-in configured to route said payment messages to the portal when said payment messages match rules specified within said composite profile."

Referring to paragraph [0027], Schuba teaches:

Independent claim 7 describes the initiation of a filter of a communication system. The filter requires an address of a transaction server so as to be capable of forwarding received payment requests. For this purpose the transaction server receives a filter initiation request, which is, for example, sent by a communication terminal and which prompts the transaction server to send a filter initiation message containing the address of the transaction server to the filter. The filter initiation message is received by the filter of the communication system, and the contained address is stored in the filter.

Although this passage refers to a "filter," neither this passage nor the Examiner's other cited passages, either alone or in combination, teach (i) the WSP comprises a filter plug-in; (ii) to route said payment messages to the portal (Schuba teaches routing messages to a transaction server); and (ii) when said payment messages match rules specified within composite profile. Thus, the limitations of the "WSP," "plug-in," "to the portal," and "composite profile" are all

- 1 absent from the Examiner's cited teachings. Therefore, the Examiner has failed to properly
- 2 characterize the scope and content of the applied prior art.

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For the reasons set forth in the Second Appeal Brief, and for those set forth herein, Appellant respectfully solicits the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 29, 2008

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320